



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,765	03/10/2004	Petteri Poyhonen	042933/271450	3955
826 7590 08/16/2010 ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			EXAMINER GONZALEZ, AMANCIO	
			ART UNIT 2617	PAPER NUMBER
			MAIL DATE 08/16/2010	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/797,765

Applicant(s)

POYHONEN, PETTERI

Examiner

AMANCIO GONZALEZ

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date 06/29/2010
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's arguments filed on 06/10/2010 have been fully considered, but are moot in view of the new ground of rejection based on the "Second Office Action in Chinese Application No. 200580012908.3 dated April 26, 2010," provided in Information Disclosure Statement (IDS) conjunctively submitted with the current amendment. Additionally, claim rejection under 35 USC § 112 has been withdrawn.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. **Claims 1-54** are rejected under 35 U.S.C. 103(a) as being unpatentable over Dingman et al. (US 20040024879 A1), hereafter referred to as "D1," in view of Oda et al. (US 20040005886 A1), hereafter referred to as "D2," according to the views expressed in the "Second Office Action in Chinese Application No. 200580012908.3

dated April 26, 2010," provided in Information Disclosure Statement (IDS) conjunctively submitted with the current amendment.

NOTICE: (1) The "Second Office Action in Chinese Application No. 200580012908.3 dated April 26, 2010," provided in Information Disclosure Statement (IDS) conjunctively submitted with the current amendment has been carefully analyzed and found appropriate for the consideration of the present application's claims as amended, hence being suitable to be entirely cited for the rejection rationale presented below.

(2) Although the claims are not listed in the rejection below reflecting the deleted/added limitation, it has been determined that said deletions/additions do not alter the scope of the claims and the rejection rationale applied, as indicated above, fit the limitations of the claimed invention.

Consider **claim 1** as amended.

Claim 1 recites *an apparatus in a system for establishing a communication session with a terminal*. D2 discloses a device for establishing a communication session with a terminal, and specifically (see paragraphs 0112 - 0130 on page 7, paragraphs 0145 - 0153 on page 8 of the description, and Figs. 9, 10, and 12 of D2) discloses the following technical features: the radio terminal 110a is capable of communicating via both the base station 122a and AP141a to initiate a call (corresponding to a network across which an originating client is capable of communicating in Claim 1), the CPS 131a (corresponding to the network node of Claim 1) receives an IP packet containing a call setting message via an IP network and extracts the MSISDN on the called side;

Art Unit: 2617

the CPS sends the call setting message to the radio terminal b via MSC and BS (corresponding to a mobile communication network different from the IP network) and receives the response message returned from the radio terminal b via the base station and the MSC, the response message containing the IP address and port number of the IP network, such that the CPS is capable of identifying the radio terminal b via the identification of the IP network (i.e., the IP address and port number) and establishing a session with the radio terminal b. Claim 1 differs from D2 in that Claim 1 recites receiving by the network node a registration message of the terminal and registering the terminal; while in D2, the radio terminal does not register with the CPS, but firstly with other node for example NTDB in the network, and the CPS may search the registration message through the NTDB. Based on the above distinguishing technical feature, it can be determined that the practical technical problem to be solved by Claim 1 is how to acquire a terminal's registration message. However, to the skilled in the art, whether the network node originating a communication acquires the terminal's registration message from a node registered as the receiving terminal or the network node originating a communication acquires the registration message from a dedicated terminal registration node belongs to customary means in the art.

Hence, it is obvious to the skilled in the art to obtain the technical solution of Claim 1 on the basis of D2 in conjunction with the above customary means. Accordingly, Claim 1 neither has prominent substantive features nor represents notable progress, and therefore does not possess inventiveness.

Consider **claim 2**.

Dependent Claim 2 further limits Claim 1. D2 discloses (ibid.): the CPS is capable of receiving a call request from the radio terminal a, and the CPS, after receiving the response message from the radio terminal b, sends a call connection request to the terminal. Thus, when Claim 1 does not possess inventiveness, Claim 2 does not possess inventiveness either.

Consider **claim 3**.

Dependent Claim 3 further limits Claim 1. D2 discloses (ibid.): the local CPS and the remote CPS may forward the call request. Thus, when Claim 2 does not possess inventiveness, Claim 3 does not possess inventiveness either.

Consider **claim 4**.

Dependent Claim 4 further limits Claim 1. D2 discloses (ibid.): the device supports SIP protocol; to the skilled in the art, it belongs to customary means in the art that SIP proxy is used as a network node or included in a network node. Thus, when Claim 1 does not possess inventiveness, Claim 4 does not possess inventiveness either.

Consider **claim 5**.

Dependent Claim 5 further limits Claim 1. To the skilled in the art, it belongs to common knowledge in the art that the network node is capable of storing the connection request message in a buffer and retrieving the updated connection request in the buffer based upon the registration message. Thus, when Claim 1 does not possess inventiveness, Claim 5 does not possess inventiveness either.

Consider **claim 6**.

Dependent Claim 6 further limits Claim 1. D1 discloses (see paragraphs 0011-0013 and 0031-0040 of the description): the network node is capable of receiving the registration message from the terminal via at least one of a network address translator NAT and a firewall FW located between the network node and the terminal. The technical feature as disclosed in D1 plays a same role as the additional technical feature of Claim 6, i.e., receiving/filtering the registration message via NAT or FW. Thus, when Claim 1 does not possess inventiveness, Claim 6 does not possess inventiveness either.

Consider **claim 7**.

Dependent Claim 7 further limits Claim 1. D2 discloses (see paragraphs 0086-0096 of the description, and Fig. 5): before the CPS sends the call setting message, the NTDB and the HLR are capable of receiving the radio terminal's registration message first. Additionally, to the skilled in the art, to further send the registration message after the terminal receives the trigger also belongs to customary means in the art. Thus, when Claim 1 does not possess inventiveness, Claim 7 does not possess inventiveness either.

Consider **claim 8**.

Dependent Claim 8 further limits Claim 1. D2 discloses (ibid.): the CPS is located in a network, and an originating client is capable of communicating directly or indirectly via the IP network or the mobile communication network. Thus, when Claim 1 does not possess inventiveness, Claim 8 does not possess inventiveness either.

Consider **claim 9**.

Dependent Claim 9 further limits Claim 8. D2 discloses (ibid.): the network comprises one of an IP network and a mobile communication network. Thus, when Claim 8 does not possess inventiveness, Claim 9 does not possess inventiveness either.

Consider **claim 10**.

Claim 10 recites *an apparatus in a system* for establishing a communication session with a terminal. D2 discloses a device for establishing a communication session with a terminal, and specifically (see paragraphs 0112 - 0130 on page 7, paragraphs 0145 - 0153 on page 8 of the description, and Figs. 9, 10, and 12 of D2) discloses the following technical features: the radio terminal 110a is capable of communicating via both the base station 122a and AP141a to initiate a call (corresponding to a network across which an originating client is capable of communicating in Claim 10), the CPS 131a (corresponding to the network node in Claim 10) receives an IP packet containing a call setting message via an IP network and extracts the MSISDN on the called side; said CPS sends the call setting message to the radio terminal b via MSC and BS (corresponding to a mobile communication network different from the IP network) and receives the response message returned from the radio terminal b via the base station and the MSC, said response message containing the IP address and port number of the IP network, such that the CPS is capable of identifying the radio terminal b via the identification of the IP network (i.e., the IP address and port number) and establishing a session with the radio terminal b, wherein the NTDB and HLR (corresponding to the SIP proxy in Claim 10) are capable of receiving the registration message of the radio terminal via the IP network or the mobile communication network, and the CPS is

Art Unit: 2617

capable of querying the registration message of the radio terminal to the NTDB.

Accordingly, all the technical features of Claim 10 have been disclosed in D2. Moreover, Claim 10 and D2 adopt the same technical solution, relate to the same technical field, solve the same technical problem, and achieve the same technical effect. Thus, Claim 10 does not possess novelty.

Consider **claim 11**.

Dependent Claim 11 further limits Claim 10. D2 discloses (ibid.): said CPS is capable of receiving a call request from the radio terminal a, and said CPS, after receiving the response message from the radio terminal b, sends a call connection request to the terminal. Thus, when Claim 10 does not possess novelty, Claim 11 does not possess novelty either.

Consider **claim 12**.

Dependent Claim 12 further limits Claim 11. D2 discloses (ibid.): the local CPS and the remote CPS may forward the call request. Thus, when Claim 11 does not possess novelty, Claim 12 does not possess novelty either.

Consider **claim 13**.

Dependent Claim 13 further limits Claim 11. D2 discloses (ibid.): said device supports SIP protocol; to the skilled in the art, it belongs to customary means in the art that SIP proxy is used as a network node or included in a network node. Thus, when Claim 11 does not possess novelty, Claim 13 does not possess inventiveness either.

Consider **claim 14**.

Dependent Claim 14 further limits Claim 10. To the skilled in the art, it belongs to common knowledge in the art that the network node is capable of storing the connection

request message in a buffer and retrieving the updated connection request in the buffer based upon the registration message. Thus, when Claim 10 does not possess novelty, Claim 14 does not possess inventiveness either.

Consider **claim 15**.

Dependent Claim 15 further limits Claim 10. D1 discloses (see paragraphs 0011-0013 and 0031-0040 of the description): the network node is capable of receiving the registration message from the terminal via at least one of a network address translator NAT and a firewall FW located between the network node and the terminal. Thus, when Claim 10 does not possess novelty, Claim 15 does not possess inventiveness either.

Consider **claim 16**.

Dependent Claim 16 further limits Claim 10. D2 discloses (see paragraphs 0086-0096 of the description, and Fig. 5): before the CPS sends the call setting message, the NTDB and the HLR are capable of receiving the radio terminal's registration message first. Additionally, to the skilled in the art, to further send the registration message after the terminal receives the trigger also belongs to customary means in the art. Thus, when Claim 10 does not possess novelty, Claim 16 does not possess inventiveness either.

Consider **claim 17**.

Dependent Claim 17 further limits Claim 10. D2 discloses (ibid.): the CPS is located in a network, and an originating client is capable of communicating directly or indirectly via the IP network or the mobile communication network. Thus, when Claim 10 does not possess novelty, Claim 17 does not possess novelty either.

Consider **claim 18**.

Dependent Claim 18 further limits Claim 17. D2 discloses (ibid.): the network comprises one of an IP network and a mobile communication network. Thus, when Claim 17 does not possess novelty, Claim 18 does not possess novelty either.

Consider **claim 19**.

The features of method Claim 19 exactly correspond to the features of apparatus Claim 1. For the same rationale as applied against Claim 1, Claim 19 does not possess inventiveness either.

Consider **claims 20-27**.

The features of **claims 20-27** exactly correspond to the features of Claims 2, 3, 5, 4, and 6-9. For the same rationale as applied against Claims 1-9, Claims 20-27 do not possess inventiveness either.

Consider **claim 28**.

Claim 28 recites a method of establishing a communication session with a terminal. D2 discloses a method of establishing a communication session with a terminal, and specifically (see paragraphs 0112 - 0130 on page 7, paragraphs 0145 - 0153 on page 8 of the description, and Figs. 9, 10, and 12 of D2) discloses the following technical features: the radio terminal 110a is capable of communicating via both the base station 122a and AP141a to initiate a call (corresponding to a network across which an originating client is capable of communicating in Claim 28), the CPS 131a (corresponding to the network node in Claim 28) receives an IP packet containing a call setting message via an IP network and extracts the MSISDN on the called side; said CPS sends the call setting message to the radio terminal b via MSC and BS (corresponding to a mobile communication network different from the IP network) and

receives the response message returned from the radio terminal b via the base station and the MSC, said response message containing the IP address and port number of the IP network, such that the CPS is capable of identifying the radio terminal b via the identification of the IP network (i.e., the IP address and port number) and establishing a session with the radio terminal b; wherein before the CPS sending the call setting message, the NTDB and the HLR are capable of receiving the registration message of the radio terminal first. Claim 28 differs from D2 in that Claim 28 recites receiving by the network node a registration message of the terminal and registering the terminal; while in D2, the radio terminal does not register with the CPS, but firstly with other node for example NTDB in the network and the CPS may search the registration message through the NTDB. Based on the above distinguishing technical feature, it can be determined that the practical technical problem to be solved by Claim 28 is how to acquire a terminal's registration message. However, to the skilled in the art, whether the network node originating a communication acquires the terminal's registration message from a node registered as the receiving terminal or the network node originating a communication acquires the registration message from a dedicated terminal registration node belongs to customary means in the art. Hence, it is obvious to the skilled in the art to obtain the technical solution of Claim 28 on the basis of D2 in conjunction with the above customary means. Accordingly, Claim 28 neither has prominent substantive features nor represents notable progress, and therefore does not possess inventiveness.

Consider **claims 29-36**.

The features of Claims 29-36 exactly correspond to the features of Claims 20 - 27. For the same rationale as applied against Claims 20 - 27, Claims 29-36 do not possess inventiveness either.

Consider **claim 37**.

Claim 37 recites a terminal. D2 discloses a terminal, and specifically (see paragraphs 0112 - 0130 on page 7, paragraphs 0145 - 0153 on page 8 of the description, and Figs. 9, 10, and 12 of D2) discloses the following technical features: the radio terminal 110a is capable of communicating via both the base station 122a and AP141a to initiate a call (corresponding to a network across which an originating client is capable of communicating in Claim 37), the CPS 131a (corresponding to the network node in Claim 37) receives an IP packet containing a call setting message via an IP network and extracts the MSISDN on the called side; said CPS sends the call setting message to the radio terminal b via MSC and BS (corresponding to a mobile communication network different from the IP network) and receives the response message returned from the radio terminal b via the base station and the MSC, said response message containing the IP address and port number of the IP network, such that the CPS is capable of identifying the radio terminal b via the identification of the IP network (i.e., the IP address and port number) and establishing a session with the radio terminal b; the radio terminal comprises a CPU (corresponding to the controller in Claim 37) which receives a signal sent from the network side and processes the signal. Claim 37 differs from D2 in that Claim 37 recites receiving by the network node a registration message of the terminal and registering the terminal; while in D2, the radio terminal does not register with the CPS, but firstly with other node for example NTDB in

the network and the CPS may search the registration message through the NTDB.

Based on the above distinguishing technical feature, it can be determined that the practical technical problem to be solved by Claim 37 is how to acquire a terminal's registration message. However, to the skilled in the art, whether the network node originating a communication acquires the terminal's registration message from a node registered as the receiving terminal or the network node originating a communication acquires the registration message from a dedicated terminal registration node belongs to customary means in the art. Hence, it is obvious to the skilled in the art to obtain the technical solution of Claim 37 on the basis of D2 in conjunction with the above customary means. Accordingly, Claim 37 neither has prominent substantive features nor represents notable progress, and therefore does not possess inventiveness.

Consider **claims 38-45**.

The features of Claims 38 - 45 exactly correspond to the features of Claims 29 - 36. To the skilled in the art, it belongs to customary means in the art to perform a response function by a controller. With reference to the comments on Claims 29 - 36, Claims 38 - 43 do not possess inventiveness either.

Consider **claim 46**.

Claim 46 recites a terminal located within one of a mobile network and a private network. D2 discloses a terminal, and specifically (see paragraphs 0112 - 0130 on page 7, paragraphs 0145 - 0153 on page 8 of the description, and Figs. 9, 10, and 12 of D2) discloses the following technical features: the radio terminal is located in the IP network and a private network; the radio terminal 110a is capable of communicating via both the base station 122a and AP141a to initiate a call (corresponding to a network across

which an originating client is capable of communicating in Claim 46), the CPS 131a (corresponding to the network node in Claim 46) receives an IP packet containing a call setting message via an IP network and extracts the MSISDN on the called side; said CPS sends the call setting message to the radio terminal b via MSC and BS (corresponding to a mobile communication network different from the IP network) and receives the response message returned from the radio terminal b via the base station and the MSC, said response message containing the IP address and port number of the IP network, such that the CPS is capable of identifying the radio terminal b via the identification of the IP network (i.e., the IP address and port number) and establishing a session with the radio terminal b; wherein before the CPS sending the call setting message, the NTDB and the HLR are capable of receiving the registration message of the radio terminal first. Claim 46 differs from D2 in that Claim 46 recites receiving by the network node a registration message of the terminal and registering the terminal; while in D2, the radio terminal does not register with the CPS, but firstly with other node for example NTDB in the network and the CPS may search the registration message through the NTDB. Based on the above distinguishing technical feature, it can be determined that the practical technical problem to be solved by Claim 46 is how to acquire a terminal's registration message. However, to the skilled in the art, whether the network node originating a communication acquires the terminal's registration message from a node registered as the receiving terminal or the network node originating a communication acquires the registration message from a dedicated terminal registration node belongs to customary means in the art. Hence, it is obvious to the skilled in the art to obtain the technical solution of Claim 46 on the basis of D2 in conjunction with the

Art Unit: 2617

above customary means. Accordingly, Claim 46 neither has prominent substantive features nor represents notable progress, and therefore does not possess inventiveness.

Consider **claims 47-54**.

The features of Claims 47-54 exactly correspond to the features of Claims 38 - 45. For the same rationale as applied against Claims 38-45, Claims 47-54 do not possess inventiveness either.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Amancio González, whose telephone number is (571) 270-1106. The Examiner can normally be reached on Monday-Thursday from 8:00am to 5:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Dwayne Bost, can be reached at (571) 272-7023. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Art Unit: 2617

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

/Nghi H. Ly/

Primary Examiner, Art Unit 2617

AG/ag

August 4, 2010